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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,107	06/25/2004	Remi Valero	1004900-000263	7911

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EXAMINER

HANOR, SERENA L

ART UNIT	PAPER NUMBER
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4116

NOTIFICATION DATE	DELIVERY MODE
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01/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/500,107	Applicant(s) VALERO ET AL.
	Examiner SERENA L. HANOR	Art Unit 4116

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-44 is/are pending in the application.
- 4a) Of the above claim(s) 45-47, 49, 50 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/25/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election Acknowledged

1. Applicant's election with traverse of Group I, Claims 28-44, in the reply filed on 11/09/2007 is acknowledged. The traversal is on the ground(s) that the claims, as currently amended, share a common technical feature. As mentioned in previous office action, the special technical feature which is referred to Annex B of Appendix A1 of the MPEP(Administrative Instructions under the PCT, "Unity of Invention"). Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed technical features. The express "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art."(Rule 13.2). Applicant's argument is not found persuasive because the technical feature is not novel over the prior art and fails to become special technical feature as noted in previous office action. See the original Restriction Requirement dated 09/10/2007.

The requirement is still deemed proper and is therefore made FINAL.

2. Newly submitted claim 55 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the so-called common technical feature is not novel over the prior art. See the original Restriction Requirement dated 09/10/2007.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claim 55 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Status of Application

3. Claims 1-27, 48, and 51-54 have been cancelled.
4. Claims 45-47, 49-50, and 55 have been withdrawn as being drawn to a non-elected invention.
5. Claims 28-44, Group I, have been elected.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 28-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bomal et al (US 5,876,494).

Bomal et al discloses a process for preparing precipitated silica. An acidifying agent is added to an initial base stock comprising a silicate of alkali metal with a silicate concentration, expressed as SiO₂, lower than about 20 g/l is until said base stock is neutralized (col. 3 lines 1-6). The acidifying agent may be sulfuric acid, nitric acid, hydrochloric acid, acetic acid, formic acid, or carbonic acid (col. 3 lines 41-44). It may have a normality of 0.4-36N and a concentration of 40-180 g/l (col. 3 lines 45-50). The silicate may have a concentration of 40-330 g/l (col. 3 lines 55-57). Additional acidifying agent and silicate are then simultaneously added to the reaction mixture while

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maintaining a pH of 7-9 (col. 3 lines 7-12, col. 5 lines 1-5). Example 1 discloses the simultaneous addition of acidifying agent and silicate occurring over 90 minutes (col. 11, lines 6-12). An aluminum compound and a silicate are added, and then additional acidifying agent is finally added such that pH of the mixture is 3-6.5 before the mixture is allowed to undergo a maturation step (col. 5 lines 62-67, col. 6 lines 1-18). The same acidifying agent may be used throughout the whole process (col. 6 lines 12-15). The mixture is finally filtered and dried to obtain a cake, and said cake is disintegrated (col. 5 lines 16-21). The temperature of the reaction is 60-98°C (col. 6 lines 33-34).

All the critical elements required by the instant claims are well taught. And thus, the claims are properly included in this rejection as being anticipated by the prior art of the record.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 28, 34-36, and 42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 25 of copending Application No. 10/583,417. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to a similar process of producing precipitated silica involving the mixture of a silicate and an acidifying agent. Both processes utilize a feedstock wherein the silicate concentration, expressed in SiO₂ equivalents, is less than or equal to 15 g/l, bring the pH of the medium to a value of 7-8 and the silicon concentration in the medium, expressed in SiO₂ equivalents, to less than or equal to 35 g/l by simultaneously adding a silicate and an acidifying agent, add an acidifying agent to the obtained medium to bring the pH to 3-6.5, and filter and dry the resulting aqueous silica dispersion to obtain a filter cake where the scope of the invention is overlapping each other and obvious to each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 28, 30, 34-36, and 42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 33, 35-39, 57, and 61-62 of copending Application No. 11/921,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose a similar process of producing precipitated silica where the scope of the invention is overlapping each other and obvious to each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

11. Claims 28-44 have been rejected.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SERENA L. HANOR whose telephone number is (571)270-3593. The examiner can normally be reached on Monday - Thursday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SLH

/Vickie Kim/
Supervisory Patent Examiner, Art Unit 4116